REMARKS – General

Claim Rejections under 35 USC §101:

The most recent Office Action (OA) rejects claims 32-80 and 93-98 as being unpatentable under 35 USC §101. Specifically, the OA states that independent claims 50 and 93 recite a system and a device, without any structure and that is comprised solely of codes, which is non-statutory. The OA further states that software not embodied in a computer readable media is non-statutory subject matter.

In response, Applicants note that the Federal Circuit has held that laws of nature, physical phenomena, and abstract ideas are the only three exceptions to §101 set forth by the Supreme Court. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). The court in *State Street* held that a machine programmed with software is statutory subject matter..." *Id.* at 1375. This is confirmed in MPEP Section 2106 IV B 1, which states, "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Section 2106 states that "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component."

With respect to claim 32, from which claims 33-49 depend, Applicant has amended the claim to recite the data packet being "…stored within a computer readable memory medium of a target device…" Support for the amendment is found in claim 81 as originally filed and paragraph 0038 of the specification. Applicants respectfully submit that the claim of a software code, delivered to and stored within computer hardware, i.e. the target device, is statutory subject matter. Applicants respectfully request reconsideration of the rejection.

With respect to claim 50, from which claims 51-92 depend, Applicant has amended claim 50 to recite "a transmission-based billing system residing in a memory in a computer environment…" Support for the amendment is found in paragraph 0040 and FIG. 4. Applicants respectfully submit that the claim of a software system residing in a

memory of a computer environment is statutory subject matter as set forth in 35 USC §101. Applicants respectfully request reconsideration of the rejection.

With respect to claim 93, from which claims 94-98 depend, Applicant has amended the claim to recite the modified content application being "…stored within a computer readable memory medium of the wireless device…", thereby reciting software embodied in a computer readable media, i.e. data components of the wireless device. Support for the amendment is found in Paragraph 0038, claim 81, and claim 96 as originally filed. Applicants respectfully submit that the claim of a software application, running on hardware, i.e. the wireless device, is statutory subject matter. Applicants respectfully request reconsideration of the rejection.

Claim Rejections under 35 USC §112:

The OA rejects claims 32-80 and 93-98 as being unpatentable under 35 USC §112. The OA generally submits, "The claims are in narrative form and are replete with indefinite and functional or operational language." The OA states that claims 32-80 and 93-98 have no structure because they lack elements for implementing the scope of the invention.

Applicants note that many of these claims have been amended in responding to the rejections under 35 USC §101 above. Further, Applicants respectfully rely upon MPEP §2173.01, which states that an "[a]pplicant *may use functional language*, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210 (CCPA 1971), a claim may *not be rejected* because of the type of language used to define the subject matter for which patent protection is sought."

With respect to claim 32, from which claims 33-49 depend, Applicants have amended this claim to recite further elements for implementing the scope of the invention. Specifically, Applicants have included a "content modifier" for instrumenting the data packet and a "modified content application" for inserting billing data. Support for the content modifier is found in paragraph 0040, while support for the modified content application is found in paragraph 0038 of the specification as originally filed. The

dependent claims have been similarly modified. Applicants respectfully request reconsideration of these claims in light of the comments and amendments.

With respect to claims 50-80, Applicants have likewise amended the claims to recite the modified content application and the content modifier, which are elements configured to implement the scope of the invention. Claims 62, 73, 75-76, and 79 have been canceled. Applicant respectfully submits that all elements for implementing the scope of the invention recited in claims 50-61, 63-72, 74, 77-78, and 80 are properly set forth in the claims. Specifically, the content modifier, the modified content application, the billing manager, the provisioning manager, the packet detecting and forwarding module, the accounting program, and the proxy server are set forth in the claims. Applicants believe claims 50-61, 63-72, 74, 77-78, and 80 to be in proper form, and that the §112 rejection is overcome. Applicants respectfully request reconsideration of the rejection in light of the amendments.

With respect to claims 93-98, Applicant has canceled claims 97-98. Applicant respectfully submits that all elements for implementing the scope of the invention are properly set forth in remaining claims 93-96. Specifically, a modified content application, a library, and a memory are set forth. While functional language does appear in the claims, Applicants respectfully note above that there is no prohibition against functional language. Indeed, means plus function claims are by definition replete with functional language. Further MPEP §2173.01 expressly states that applicants may use functional language as claim terminology.

Applicants believe all rejections under §112 to be overcome. Applicants respectfully request, should the Examiner disagree, that any rejections be set forth with specificity so that they may be addressed. Applicants respectfully request reconsideration of the claims in light of these remarks and amendments.

Allowable Subject Matter:

Applicants kindly thank the Examiner for noting that claims 1-31 and 81-92 are allowed over the prior art.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit. If any matter may be more easily handled by telephone, the undersigned attorney welcomes telephone calls from the Examiner.

Respectfully submitted,
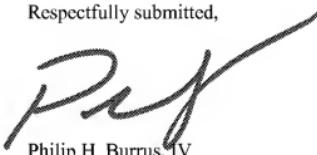
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